UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/086,089	02/28/2002	Scott P. Schreer	3247/NJJ	3357

26304 7590 06/09/2006

KATTEN MUCHIN ROSENMAN LLP
575 MADISON AVENUE
NEW YORK, NY 10022-2585

EXAMINER	
SALCE, JASON P	
ART UNIT	**PAPER NUMBER**
2623	

DATE MAILED: 06/09/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	10/086,089	SCHREER, SCOTT P.	
	Examiner	Art Unit	
	Jason P. Salce	2623	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *20 March 2006*.

2a)☒ This action is **FINAL**. 2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-11* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-11* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ .
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

DETAILED ACTION

Response to Arguments

1. Applicant's arguments filed 3/20/2006 have been fully considered but they are not persuasive.

In the arguments dated 10/03/2005, Applicant had noted that after the discussion in an interview, that Ginter failed to teach that the users monitor the broadcast and that Ginter only taught monitoring at another location. After amending the claims, the examiner rejected the claims under 112 1st paragraph because the specification does not specifically teach that users perform the monitoring and from the various portions of the specification of the instant application that at best, end-user **organizations** are taught, but not end users at a client side. Applicant's representative agreed with the examiner and stated that the claims would be amended to state a monitoring station.

Applicant continues to argue that the specification teaches that all end-users receiving the broadcast, simply by the user of the term "broadcast" and cites various portions of the instant application's specification where a broadcast of content is disclosed. Applicant also recites various definitions of how the word "broadcast" provides support for the end-users that publicly receive the broadcast and monitor the content. The examiner notes that every definition provided by Applicant states no specific point in the network that is performing the monitoring. Note that throughout the specification, that the end-user **organizations** are performing the monitoring. The examiner notes that an organization is not the general public who receives a broadcast for viewing or listening purposes. Therefore, the end-user organization is far from a

user who tunes to a radio station or tunes to a specific channel to listen or view content, respectively.

In view of Applicant's return to the previously discussed application of the Ginter reference, Applicant again argues that Ginter fails to teach anything about a public broadcast. The examiner disagrees and notes Column 3, Line 28, which clearly states that the distribution of content can be performed using a **digital broadcast**. Further note that Column 14, Lines 5-28, which describes almost every feasible distribution method possible, which includes radio and/or television **broadcasts**. Further note that Column 18, Lines 12-13 also disclose broadcasting the content. The examiner alones that from a word search alone, that the Ginter clearly teaches broadcasting the content in eleven (not including the cited portions above) different portion of the Günter's specification. Not only does Ginter teach broadcasting the content, but also teaches that "corporations, government agencies, and/or individual end-users" can perform the processing of the content.

Applicant further argues that Ginter fails to teach monitoring the public broadcast. The examiner disagrees and notes Column 3, Lines 34-35 that clearly states that Ginter provides metering and monitoring technology. Further note Column 23, Lines 51-59 which states, "*support trusted chain of handling capabilities for pathways of distributed electronic information and/or for content usage related information. Such chains may extend, for example, from a content creator, to a distributor, a redistributors, a client user, and then may provide a pathway for securely reporting the same and/or differing usage information to one or more auditors, such as to one or more independent*

clearinghouses". In other words, any part of the distribution network can be configured to report the content usage information (monitored content). Further note Column 48, Lines 44-45, which clearly states that the usage of electronic information can be securely monitored. Therefore, Ginter clearly teaches that the electronic content (that is broadcasted) is monitored.

Applicant further argues that Ginter fails to teach detecting from the broadcast. The examiner disagrees and notes Column 3, Line 25, for one example of many, where Ginter teaches detection of the electronic content (that is broadcasted).

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

2. Claims 1-7 and 9-11 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ginter et al. (U.S. Patent No. 6,253,193) in view of Wiser et al. (U.S. Patent No. 6,385,596).

Referring to claim 1, Ginter discloses compensating at least one rights holder responsible for content of a digital audio recording file for the public performance of the content (see Column 3, Lines 20-24 and Column 4, Lines 8-13 for the present invention employing a system to compensate a digital rights holder for content of a digital audio recording file (see Column 4, Lines 17-20) for the public performance of the content

(note that is the electronic information is broadcasted, then it is broadcasted to be consumed by a listener/viewer), the content being included in a public broadcast (see Column 3, Lines 24-29 for monitoring the content distributed from a digital broadcast and note arguments above for further portions of Ginter that teach that the electronic content can be broadcasted). Also note Column 260, Lines 11-15 for tracking "live performances", which are public performances.

Ginter also discloses associating an identification code with the digital audio recording file to produce an identified digital audio recording file (see Column 130, Lines 7-11 for "embedded" content in a VDE object and Column 58, Lines 43-46 and Lines 59-64 for the VDE object containing a digital audio recording and further note Figure 20 for a content object containing identification information).

Ginter also discloses generating an identification record correlating to the identification code and the digital audio recording file (see Column 153, Line 32 through Column 154, Line 67 for an object registry containing a database that stores a list all of content objects that a user receives).

Ginter also discloses broadcasting the identified digital audio recording file as an encoded audio signal, in the public broadcast (see again Column 127, Lines 6-8 for "content delivery" over the media and Column 53, Lines 1-10 for broadcasting the information), wherein the public broadcast being made by one of a radio or television station broadcast (see Column 14, Lines 5-10), including cable and satellite networks and Internet websites (see Column 18, Lines 60-64).

Ginter also discloses that the public broadcast is remotely receivable simultaneously by a plurality of users constituting audience members of the public receiving the audio signal being publicly broadcast (see Column 127, Lines 45-49 for sending the VDE object to an electrical appliance). Also note above that television broadcasting networks can be used, which simultaneously transmit content to a plurality of audience members of a public broadcast.

Ginter also discloses feeding, storing and correlating (by said user member of the audience) the identification code and data related to the public broadcast and unrelated to the users constituting the audience members of the public and monitoring the broadcast (see Column 153, Lines 53-59 for storing registration information relating to the VDE data in a secure database 610) that stores and associates the identification code, and based on said identification code records and stores the identification code (see Column 153, Lines 62-64 for storing data from the VDE object 300) and transmission and broadcast related data in a batch file (see also saving shipping (transmission) and receiving (broadcast) data in tables (batch file) 444 and 446 in Figure 16), said broadcast related data including a date that the encoded audio signal was monitored, a time of day that the encoded audio signal was monitored (Column 155, Lines 22-23), and the duration of the monitored encoded audio signal (see Column 152, Lines 26-27 for a data length, which in the case of an audio file defines how long the song is). Also note that the system of Ginter discloses tracking VDE, which is the content that is broadcast, and there inherently teaches the limitation, "unrelated to the users constituting the audience members of the public".

Ginter teaches compensating a user for his/her work (see Column 3, Lines 20-24 and Column 4, Lines 8-18), but fails to disclose decoding and importing the batch file into a first database that catalogs performance, transmission and broadcast of the encoded audio signal and using the first database to accurately compensate the at least one performance artist responsible for generating content on said digital audio recording file.

Wiser discloses a logging module 1014, which catalogs performance, transmission and broadcast of the encoded audio signal (see Column 23, Lines 18-19 for logging each purchase of a media data file 200, which if purchased are transmitted/broadcasted (see Column 11, Lines 53-55). Wiser also discloses that these logs are used to accurately compensate the at least one performance artist responsible for generating content on said digital audio recording file (see Column 23, Lines 21-30 and Column 11, Lines 55-57 for reporting royalty payments). Therefore, Wiser discloses decoding and importing the batch file into a first database that catalogs public performance, based upon the incidence of the public broadcast and unrelated to the number of actual audience users and broadcast of the audio signal.

At the time the invention was made, it would have been obvious to a person of ordinary skill in the art, to modify the VDE system, as taught by Ginter, using the payment and reporting tracking system, as taught by Wiser, for the purpose of allowing music industry participants to protect their copyrights and could be used by rights reporting agencies to bill distributors for royalties associated with the volume of electronic distribution of the media data files (see Column 11, Lines 57-61 of Wiser).

Claim 2 corresponds to claim 1, where Wiser discloses that the identification code embedded in the audio signal is a digital watermark (see Column 7, Lines 17-19).

Claim 3 corresponds to claim 1, where Ginter discloses embedding the identification code is performed by encoding software (see Column 6, Lines 45-55).

Claim 4 corresponds to claim 1, where Wiser discloses the identification code is in the form of a non-audible digital signal that is not rendered inoperable by one or more generations of analog taping and broadcast compressions (see the rejection of claim 2, which discloses the encoding of a watermark, which is not rendered inoperable by such analog deficiencies).

Claim 5 corresponds to claim 1, where Wiser discloses a second digital work library database to match the embedded identification code with the title of a digital audio work and its associated file information, and importing said title and associated file information from the second digital work library database to the first database (see element 120 in Figure 1 and Column 12, Lines 58-60 for a second database used to store the audio file and descriptive data (see Column 6, Lines 48-65)).

Claim 6 corresponds to claim 5, where Wiser discloses using the embedded identification code to match the digital audio work's title to the recorded and stored transmission or broadcast related data (see Column 14, Lines 52-60 for searching database 120 if the audio file is not stored at content manager 112) and Ginter discloses printing a digital audio work usage report having both the title of the digital audio work and the transmission and broadcast related data (see Column 228, Lines 45-56).

Claim 7 corresponds to claim 1, where the examiner notes that multimedia includes both audio and video, therefore the digital audio recording file is multimedia.

Referring to claims 9-11, see the rejection of claims 1 and 5-6 respectively.

3. Claim 8 is rejected under 35 U.S.C. 103(a) as being unpatentable over Ginter et al. (U.S. Patent No. 6,253,193) in view of Wiser et al. (U.S. Patent No. 6,385,596) in further view of BMI (What is a Cue Sheet?).

Referring to claim 8, Ginter and Wiser teach the limitations of claim 1, but fail to disclose the use of a cue sheet.

BMI teaches using a cue sheet for keeping track of all the music used in films and on television shows (see Page 1, Third Paragraph for types of information in a cue sheet and Pages 2 and 3 for a sample cue sheet).

At the time the invention was made, it would have been obvious to a person of ordinary skill in the art, to modify the information being tracked by Ginter and Wiser, using BMI's cue sheet, as taught by BMI, for the purpose of ensuring its writers and publishers receive the royalties due to them (see Page 1, First Paragraph of BMI).

Conclusion

4. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within

TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

5. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jason P. Salce whose telephone number is (571) 272-7301. The examiner can normally be reached on M-F 9am-6pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John Miller can be reached on (571) 272-7353. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Jason P Salce
Primary Examiner

Art Unit 2623

June 6, 2006